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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,918	06/08/2005	Yoshifumi Kojima	P70630US0	4752
136 7590 01/25/2008 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			EXAMINER PEPITONE, MICHAEL F	
			ART UNIT 1796	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,918

Applicant(s)

KOJIMA ET AL.

Examiner

Michael Pepitone

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/6/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention. The applicant has failed to incorporate a foreign test standard in the specification.

The incorporation of essential material by reference to a foreign application or foreign patent or to a publication inserted in the specification is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or applicants attorney or agent, stating that the amendatory material consists of the same application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157; *In re Hawkins*, 486 F.2d 569, 179 USPQ 163; *In re Hawkins*, 486 F.2d 569, 179 USPQ 167.

In order to avoid a 35 U.S.C. § 112, first paragraph rejection when the applicant attempts to incorporate a foreign test standard in the specification (see pg. 4, ln. 11, 25-26; pg. 9, ln. 1, 12; pg. 11, ln. 2, and abstract), it is recommended that the applicant further incorporates the standard in the specification or submit an English translation of the standard.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-14 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "the gasket" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the molded gasket" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the sealing structure" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 112 and § 101

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 12: Claim 12 provides for the use of the composition of claim 8 as a gasket, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinoshita *et al.* (US 2001/0053816).

Regarding claims 8-9: Kinoshita *et al.* teaches a thermoplastic elastomer composition (¶ 7) comprising an ethylene- α -olefin copolymer, in an amount of 40-90 wt% (¶ 7, 23-25), a

crystalline polyolefin resin, in an amount of 1-100 wt% [instant claim 9] (§ 7, 11-13), a non aromatic softening agent, in an amount of 0.5-200 wt% (§ 45-46), and an organic peroxide, in an amount of 0.02-3 wt% (§ 53, 55, 57).

Regarding claim 10: Kinoshita *et al.* teaches the basic claimed composition [as set forth above with respect to claim 8]. The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents. Therefore, the claimed effects and physical properties, i.e. a compression set after 168 hours of standing time at 100 °C is 50% or less, would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Regarding claim 11: Kinoshita *et al.* teaches the basic claimed composition [as set forth above with respect to claims 8 and 9]. The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents. Therefore, the claimed effects and physical properties, i.e. a compression set after 168 hours of standing time at 100 °C is 50% or less, would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Kunikane *et al.* (US 6,308,961), or Toyosawa *et al.* (US 6,399,696).

Regarding claim 15: Kunikane *et al.* teaches a gasket which meets the limitations set forth in instant claim 15 (Figures 1-3).

Toyosawa *et al.* teaches a gasket which meets the limitations set forth in instant claim 15 (Figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Kinoshita *et al.* (US 2001/0053816) as applied to claim 8 above, and further in view of Matsunaga *et al.* (US 2005/0020740).

Regarding claims 12-14: Kinoshita *et al.* teaches the basic claimed composition [as set forth above with respect to claims 8]. Kinoshita *et al.* teaches that the thermoplastic elastomeric composition can be formed into various molded products by processes such as injection molding (§ 61, 64). Kinoshita *et al.* does not teach a gasket [instant claim 12], a molded gasket integrally molded with a metal sheet [instant claim 13], or the sealing structure of instant claim 14. However, Matsunaga *et al.* teaches an ethylene- α -olefin copolymer composition suitable for molding (§ 12-13, 22, 24-25, 261). Kinoshita *et al.* and Matsunaga *et al.* are combinable because they are concerned with a similar technical difficulty, namely the preparation of ethylene- α -olefin copolymer composition suitable for injection molding. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined a gasket [instant claim 12] (§ 261), a molded gasket integrally molded with a metal sheet [instant claim 13] (§ 265), and utilizing an adhesive [instant claim 14] (§ 265-266), as taught by Matsunaga *et al.* in the invention of Kinoshita *et al.*, and would have been motivated to do so since Matsunaga *et al.* suggests that such molded composition yields a gasket which, when integrated with a cover by an adhesive, can achieve enhanced sealing properties (§ 13), and is an equivalent alternative means of providing a ethylene- α -olefin copolymer composition suitable for injection molding.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8-13 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 7,050,263. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compositions overlap in scope.

Claims 8-13 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,099,111. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compositions overlap in scope.

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. See attached form PTO-892.

Correspondence

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pepitone whose telephone number is 571-270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MFP
17-January-08

A handwritten signature in black ink, appearing to read 'M Eashoo', with a long horizontal flourish extending to the right.

MARK EASHOO, PH.D.
SUPERVISORY PATENT EXAMINER

22/Jan/08